

REMARKS

Claims 1-41 are pending in the present application. Claims 1, 4, 6, 7, 10, 11, 14, 15, 16, 17, 20, 21, 22, 25, 26, 27, 28, 31, 32, 35-38, and 41 are amended. Support for the amendments may be found in the originally filed specification on at least page 22, lines 6-14 and 26-31, and page 23, lines 1-3. No new matter is added by this amendment. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 102, Anticipation

The Office Action rejects claims 1, 4-9, 11, 15-19, 21-22, 25-30, 32, and 35-40 under 35 U.S.C. § 102(c) as being allegedly anticipated by *Gilbert* (U.S. Patent No. 6,529,942). This rejection is respectfully traversed.

Gilbert teaches a system and method for providing recipient specific formats for electronic mail. A composer of an email message may customize the format of text within the email message by embedding codes within the message. The cited portion of *Gilbert* states:

The present invention is embodied in a functional component that recognizes embedded processing codes for a specific recipient in an e-mail system. This functional component can be integrated into e-mail software or can exist separate from the electronic mail software. Upon recognition of an embedded text format command, the functional component changes the font characteristics of selected text for specific recipients based upon an identifier code identifying each recipient's message. Individualized copies of the original message are automatically created for each recipient. The invention thus allows a single message to be modified for more than one recipient such that individual modifications corresponding to a particular recipient are received only by that recipient. A computerized network serving as an environment for the present invention is first described. Next, the processing steps required to format text for a specific recipient are described along with the processing steps necessary for automatically creating e-mail messages. Examples of e-mail messages with embedded processing codes are also presented.

Gilbert, col. 3, lines 3-22. Thus, *Gilbert* teaches that when a composer of an electronic mail wishes to customize the format for an email message, the composer must

deliberately embed specific commands within the message for each intended recipient. Customized format is only effectuated through these embedded commands.

In contradistinction, the present invention allows customization of an electronic mail message based on one or more recipient profiles. Claim 1 recites:

1. A method of formatting an electronic mail message, comprising:
retrieving one or more recipient profiles from storage, wherein the one or more recipient profiles identify an electronic mail message format for a corresponding recipient;
identifying a recipient of an electronic mail message; and
formatting content of the electronic mail message based on a recipient profile corresponding to the identified recipient.

Gilbert does not teach or suggest at least retrieving one or more recipient profiles from storage, as recited in claim 1, for example. The Office Action alleges that *Gilbert* teaches this feature at col. 3, lines 3-22, which is reproduced above. Clearly, the cited portion does not teach retrieving recipient profiles from storage. In fact, the word "profile" does not appear anywhere within the *Gilbert* disclosure.

Gilbert does solve a similar problem as the present invention; however, *Gilbert* solves the problem in a very different manner. That is, *Gilbert* solves the problem of customizing the content of email messages by embedding recipient-specific formatting commands within the document itself. *Gilbert* does not teach or suggest retrieving one or more recipient profiles and formatting content of the electronic message based on a recipient profile corresponding to the intended recipient, as recited in claim 1, for example.

The applied reference does not teach or suggest each and every claim limitation; therefore, *Gilbert* does not anticipate claim 1. Independent claims 11, 21, 22, and 32 recite subject matter addressed above with respect to claim 1 and are allowable for similar reasons. Since claims 4-9, 15-19, 25-30, and 35-40 depend from claims 1, 11, 22, and 32, the same distinctions between *Gilbert* and the invention recited in claims 1, 11, 22, and 32 apply for these claims. Additionally, claims 4-9, 15-19, 25-30, and 35-40 recite other additional combinations of features not suggested by the reference.

Applicant notes that claim 15 is rejected under 35 U.S.C. § 102(e), but that claim 14, on which claim 15 depends, is rejected under 35 U.S.C. § 103(a). As such, the Office Action acknowledges that *Gilbert* does not anticipate claim 14. Therefore, it follows that

Gilbert also does not anticipate claim 15 due to its dependency on claim 14. For at least the above reasons, the rejection of claim 15 as being allegedly anticipated by *Gilbert* under 35 U.S.C. § 102(e) is improper and should be withdrawn.

With respect to claims 6, 16, 27, and 37, *Gilbert* fails to teach or suggest wherein the electronic mail message format settings include at least one of closing information, stationery, or whether to use spell check. *Gilbert* teaches that recipient-specific formatting commands may be embedded within a message in association with particular text. Thus, these formatting commands may include text size, color, bold, italic, superscript, subscript, etc. However, *Gilbert* does not teach or suggest electronic mail message format settings that include closing information, stationery, or whether to use spell check, as recited in claims 6, 16, 27, and 37.

Therefore, Applicant respectfully requests withdrawal of the rejection of claims 1, 4-9, 11, 15-19, 21-22, 25-30, 32, and 35-40 under 35 U.S.C. § 102(e).

Furthermore, *Gilbert* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. *Gilbert* actually teaches away from the presently claimed invention because it teaches embedding recipient-specific formatting commands into an email message, as opposed to using one or more recipient profiles that identify an electronic mail message format for a corresponding recipient, as in the presently claimed invention. Absent the Office Action pointing out some teaching or incentive to implement *Gilbert* to use recipient profiles to format the content of electronic mail messages, one of ordinary skill in the art would not be led to modify *Gilbert* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Gilbert* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicant's disclosure as a template to make the necessary changes to reach the claimed invention.

II. 35 U.S.C. § 103, Obviousness

The Office Action rejects claims 2-3, 10, 12-14, 20, 23-24, 31, 33-34, and 41 under 35 U.S.C. § 103(a) as being unpatentable over *Gilbert* in view of *Schuetze et al.* (U.S. Patent No. 6,101,320). This rejection is respectfully traversed.

Claims 2, 3, 10, 12-14, 20, 23, 24, 31, 33, 34 and 41 depend from claims 1, 11, 22, and 32 and are allowable for at least the reasons stated above with respect to claims 1, 11, 22, and 32. More particularly, *Gilbert* teaches providing recipient specific formats by embedding recipient-specific formatting commands within the message. *Gilbert* does not teach or suggest retrieving one or more recipient profiles and formatting content of the electronic message based on a recipient profile corresponding to the intended recipient. *Schuetze* does not make up for the deficiencies of *Gilbert*.

Schuetze teaches an electronic mail communication system and method for exchanging electronic mail messages between organizations having dissimilar electronic mail systems. In *Schuetze*, when an electronic mail message is received at a router, the router identifies the recipient organization and changes the transmission format of the message to match the recipient's electronic mail system. However, *Schuetze* does not teach or suggest formatting the **content** of an electronic mail message. Rather, *Schuetze* is concerned with the transmission format expected by the recipient's electronic mail system.

Even if *Gilbert* and *Schuetze* could be properly combined, the proposed combination would not form the presently claimed invention. Instead, a combination of *Gilbert* and *Schuetze* would result in a composer using embedded commands to customize **content** for specific recipients and a router changing the transmission format to the format expected by the recipient's electronic mail system. *Gilbert* and *Schuetze* solve different problems and can be used together without modifying the teachings of either reference. That is, if one were to customize the **content** of an electronic message given only the teachings of the applied reference, one would look only to the teachings of *Gilbert* to solve the problem. On the other hand, if one were to implement a router that had the capability of customizing the transmission format of an electronic mail message, one would look only to the teachings of *Schuetze*. Therefore, *Gilbert* and *Schuetze*, taken individually or in combination, fail to teach or suggest the invention recited in at least claims 1, 11, 22, and 32. Thus, a combination of *Gilbert* and *Schuetze* is insufficient to render claims 1, 11, 22, and 32 obvious. It follows that the proposed combination also fails to render dependent claims 2, 3, 10, 12-14, 20, 23, 24, 31, 33, 34 and 41 by virtue of their dependency.

Therefore, Applicant respectfully requests withdrawal of the rejection of claims 2-3, 10, 12-14, 20, 23-24, 31, 33-34, and 41 under 35 U.S.C. § 103(a).

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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